

ESTTA Tracking number: **ESTTA585468**Filing date: **02/04/2014**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**Notice of Opposition**

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	SANTONI SOCIETA' PER AZIONI		
Entity	Corporation	Citizenship	Italy
Address	Via Monte Napoleone 9 Milan, 20121 ITALY		
Attorney information	Nicholas D. Wells Wells IP Law, LLC 299 S. Main St., Suite 1300 Salt Lake City, UT 84111 UNITED STATES nwells@wellsiplaw.com Phone:801-444-7143		

Applicant Information

Application No	79129361	Publication date	02/04/2014
Opposition Filing Date	02/04/2014	Opposition Period Ends	03/06/2014
International Registration No.	1158247	International Registration Date	03/19/2013
Applicant	ZARCO - FABRICA DE CALÃ#ADO LDA RUA OLIVEIRA FIGUEIREDO, 182/202 - SÃ#O JOÃ#O DA MADEIRA, PTX P3700293 PTX		

Goods/Services Affected by Opposition


Class 025. First Use: 0 First Use In Commerce: 0
All goods and services in the class are opposed, namely: Footwear for men and women and leather belts


Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	2270643	Application Date	06/10/1998
Registration Date	08/17/1999	Foreign Priority Date	NONE
Word Mark	SANTONI		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 018. First use: First Use: 1997/09/08 First Use In Commerce: 1997/09/08 handbags, shoulder bags, travelling bags, credit card cases, document cases, passport cases, keycases, briefcases, wallets, umbrellas Class 025. First use: First Use: 1989/12/31 First Use In Commerce: 1989/12/31 [shirts, coats, overcoats, anoraks, blousons, jerkins,] belts, neckties, socks and stockings, footwear

U.S. Registration No.	2350796	Application Date	06/10/1998
Registration Date	05/16/2000	Foreign Priority Date	NONE
Word Mark	SANTONI		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1997/09/10 First Use In Commerce: 1997/09/10 [T-shirts, jackets, trousers,] gloves, scarves, pullovers, cardigans, sweaters [, jerseys, raincoats]		

Attachments	75499832#TMSN.gif(bytes) 75499852#TMSN.gif(bytes) SANTOS BY CARLOS SANTOS-TTAB Opposition.pdf(75844 bytes) SANTONI--US Reg No 2270643.pdf(125537 bytes) SANTONI--US Reg No 2350796.pdf(123711 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Nicholas Wells/
Name	Nicholas D. Wells
Date	02/04/2014

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Mark: SANTOS BY CARLOS SANTOS

Serial No.: 79129361

Published: February 4, 2014

SANTONI SOCIETA' PER AZIONI

Opposer

v.

ZARCO - FABRICA DE CALÇADO LDA

Applicant

Opposition No. _____

NOTICE OF OPPOSITION

In the matter of trademark application Serial No. 79129361 for the trademark SANTOS BY CARLOS SANTOS for “Footwear for men and women and leather belts” in International Class 025, filed March 19, 2013 and published in the Official Gazette on February 4, 2014.

Opposer SANTONI SOCIETA' PER AZIONI (“Opposer”), a corporation organized under the laws of Italy and having a place of business at Via Monte Napoleone 9, I-20121 Milan, Italy, believes it will be damaged by registration of the mark shown in the above identified application and hereby opposes the same.

The grounds for the opposition are as follows:

1. Opposer is the owner of U.S. Trademark Registration No. 2270643 for the mark SANTONI (and Design) for “handbags, shoulder bags, travelling bags, credit card cases, document cases, passport cases, keycases, briefcases, wallets, umbrellas” in International Class 018 and for "belts, neckties, socks and stockings, footwear" in International Class 025. Opposer is also the owner of U.S. Trademark Registration No. 2350796 for the mark SANTONI (and Design) for “gloves, scarves, pullovers, cardigans, sweaters" in International Class 025.
2. Opposer has used its SANTONI marks in commerce on the goods in the aforementioned registrations within the United States since at least as early as 1997.
3. Attached hereto is a copy of the TSDR records for the registrations cited in Paragraph 1. Opposer's cited registrations are valid, subsisting and enforceable.
4. Opposer has expended significant resources in the design, manufacture and promotion of its goods sold under its SANTONI mark. Opposer’s SANTONI mark has become well-known as an identifier of high-quality footwear, clothing and accessories.
5. Applicant's above identified SANTOS BY CARLOS SANTOS mark is likely, when used on or in connection with Applicant's goods, to cause confusion, or to cause mistake, or to deceive due to its being confusingly similar to Opposer’s SANTONI marks and its use in connection with goods that are identical to the goods sold by Opposer under its SANTONI mark, and on goods which travel in the same channels of trade as goods sold under Opposer’s SANTONI mark.

6. Opposer has priority of use in commerce and priority of registration of its SANTONI mark.
7. Applicant's mark consists of the term SANTOS as its predominant element. Applicant's mark is thus highly similar in appearance and in sound to the literal element of Opposer's SANTONI mark.
8. Applicant's mark is likely to be comprehended by U.S. consumers as being confusingly similar to Opposer's registered trademarks comprising the literal element SANTONI.
9. The goods to be sold by Applicant overlap the goods currently sold by Opposer under its SANTONI mark, and those goods which are not identical are related.
10. Applicant's mark is not registrable under Section 2(d) of the Lanham Act in view of Opposer's prior, continuous, ongoing and current use of its mark in commerce.
11. As a result of the use and promotion of Opposer's SANTONI mark for the goods identified above, Opposer's mark has acquired significant goodwill and has become famous prior to Applicant's first use of its mark and the filing date of its application. Opposer's mark is a famous mark within the meaning of Section 43(c) of the Lanham Act. Registration of the confusingly similar mark by Applicant will lessen the capacity of Opposer's mark to identify and distinguish the goods and services of Opposer, and is thereby likely to cause dilution of Opposer's mark.

WHEREFORE, Opposer believes that it will be damaged by registration of said mark and prays that this opposition be sustained.

Dated: Salt Lake City, Utah
February 4, 2014

WELLS IP LAW, LLC

By: /s/Nicholas D. Wells

Nicholas D. Wells
299 S. Main St., Suite 1300
Salt Lake City, Utah 84111
Telephone: (801) 444-7143
Email: nwells@wellsiplaw.com

Attorney for Opposer,
SANTONI SOCIETA' PER AZIONI

CERTIFICATE OF SERVICE

I hereby certify that on the 4th day of February 2014, I served a copy of this **OPPOSITION** on the Applicant's Attorney of Record, as designated below, by placing said copy in the United States Mail, first class, postage prepaid, addressed as follows:

LAWRENCE E. ABELMAN
ABELMAN FRAYNE & SCHWAB
666 THIRD AVENUE, 10TH FLOOR
NEW YORK, NEW YORK 10017

By: /s/Nicholas D. Wells

Nicholas D. Wells
WELLS IP LAW, LLC
299 S. Main St., Suite 1300
Salt Lake City, Utah 84111

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Mark: SANTONI



US Serial Number: 75499832

Application Filing Date: Jun. 10, 1998

US Registration Number: 2270643

Registration Date: Aug. 17, 1999

Register: Principal

Mark Type: Trademark

Status: The registration has been renewed.

Status Date: Aug. 31, 2009

Publication Date: May 25, 1999

Mark Information

Mark Literal Elements: SANTONI

Standard Character Claim: No

Mark Drawing Type: 5 - AN ILLUSTRATION DRAWING WITH WORD(S) /LETTER(S)/ NUMBER(S) INSTYLIZED FORM

Color(s) Claimed: Color is not claimed as a feature of the mark.

Related Properties Information

Claimed Ownership of US [1554687](#), [1729439](#), [2000656](#)

Registrations:

Goods and Services

Note:

The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((...)) identify any goods/services not claimed in a Section 15 affidavit of
- Asterisks *...* identify additional (new) wording in the goods/services.

For: handbags, shoulder bags, travelling bags, credit card cases, document cases, passport cases, keycases, briefcases, wallets, umbrellas

International Class(es): 018 - Primary Class

U.S Class(es): 001, 002, 003, 022, 041

Class Status: ACTIVE

Basis: 1(a)

First Use: Sep. 08, 1997

Use in Commerce: Sep. 08, 1997

For: [shirts, coats, overcoats, anoraks, blousons, jerkins,] belts, neckties, socks and stockings, footwear

International Class(es): 025 - Primary Class

U.S Class(es): 022, 039

Class Status: ACTIVE

Basis: 1(a)

First Use: Dec. 31, 1989

Use in Commerce: Dec. 31, 1989

Basis Information (Case Level)

Filed Use: Yes

Currently Use: Yes

Amended Use: No

Filed ITU: No

Currently ITU: No

Amended ITU: No

Filed 44D: No

Currently 44D: No

Amended 44D: No

Filed 44E: No

Currently 44E: No

Amended 44E: No

Filed 66A: No

Currently 66A: No

Filed No Basis: No

Currently No Basis: No

Current Owner(s) Information

Owner Name: SANTONI SOCIETA' PER AZIONI

Owner Address: VIA MONTE NAPOLEONE 9
MILANO 20121
ITALY

Legal Entity Type: CORPORATION

State or Country Where
Organized: ITALY**Attorney/Correspondence Information****Attorney of Record**

Attorney Name: Nicholas D. Wells

Docket Number: 4651.233

Attorney Primary Email nwells@wellsiplaw.com
Address:

Attorney Email Authorized: Yes

CorrespondentCorrespondent Name/Address: Nicholas D. Wells
Wells IP Law
299 South Main Street, Suite 1300
Salt Lake City, UTAH 84111
UNITED STATES

Phone: 8014447143

Fax: 2032953730

Correspondent e-mail: nwells@wellsiplaw.comCorrespondent e-mail Yes
Authorized:**Domestic Representative**

Domestic Representative Name: Nicholas D. Wells

Phone: 8014447143

Fax: 2032953730

Domestic Representative nwells@wellsiplaw.com
e-mail:Domestic Representative e-mail Yes
Authorized:**Prosecution History**

Date	Description	Proceeding Number
Nov. 08, 2013	ATTORNEY REVOKED AND/OR APPOINTED	
Nov. 08, 2013	TEAS REVOKE/APPOINT ATTORNEY RECEIVED	
Mar. 27, 2013	AUTOMATIC UPDATE OF ASSIGNMENT OF OWNERSHIP	
Aug. 31, 2009	REGISTERED AND RENEWED (FIRST RENEWAL - 10 YRS)	69471
Aug. 31, 2009	REGISTERED - SEC. 8 (10-YR) ACCEPTED/SEC. 9 GRANTED	
Aug. 28, 2009	FAX RECEIVED	
Aug. 24, 2009	POST REGISTRATION ACTION MAILED - SEC. 8 & 9	69471
Aug. 10, 2009	ASSIGNED TO PARALEGAL	69471
Aug. 06, 2009	FAX RECEIVED	
Aug. 05, 2009	TEAS SECTION 8 & 9 RECEIVED	
May 18, 2009	APPLICANT/CORRESPONDENCE CHANGES (NON-RESPONSIVE) ENTERED	88888
May 18, 2009	TEAS CHANGE OF OWNER ADDRESS RECEIVED	
Apr. 30, 2009	TEAS CHANGE OF CORRESPONDENCE RECEIVED	
Aug. 25, 2006	CASE FILE IN TIGRS	
Nov. 18, 2004	REGISTERED - SEC. 8 (6-YR) ACCEPTED & SEC. 15 ACK.	
Oct. 20, 2004	REGISTERED - SEC. 8 (6-YR) & SEC. 15 FILED	
Oct. 20, 2004	PAPER RECEIVED	
Aug. 17, 1999	REGISTERED-PRINCIPAL REGISTER	
May 25, 1999	PUBLISHED FOR OPPOSITION	
Apr. 23, 1999	NOTICE OF PUBLICATION	
Jan. 26, 1999	APPROVED FOR PUB - PRINCIPAL REGISTER	
Jan. 15, 1999	EXAMINER'S AMENDMENT MAILED	
Jan. 13, 1999	ASSIGNED TO EXAMINER	66582

Maintenance Filings or Post Registration Information

Affidavit of Continued Use: Section 8 - Accepted

Affidavit of Incontestability: Section 15 - Accepted

Renewal Date: Aug. 17, 2009

TM Staff and Location Information

TM Staff Information - None

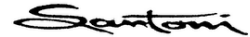
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Mark: SANTONI



US Serial Number: 75499852

Application Filing Date: Jun. 10, 1998

US Registration Number: 2350796

Registration Date: May 16, 2000

Register: Principal

Mark Type: Trademark

Status: The registration has been renewed.

Status Date: Jun. 29, 2010

Publication Date: May 04, 1999

Notice of Allowance Date: Jul. 27, 1999

Mark Information

Mark Literal Elements: SANTONI

Standard Character Claim: No

Mark Drawing Type: 5 - AN ILLUSTRATION DRAWING WITH WORD(S) /LETTER(S)/ NUMBER(S) INSTYLIZED FORM

Color(s) Claimed: Color is not claimed as a feature of the mark.

Goods and Services

Note:

The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((...)) identify any goods/services not claimed in a Section 15 affidavit of
- Asterisks *..* identify additional (new) wording in the goods/services.

For: [T-shirts, jackets, trousers,] gloves, scarves, pullovers, cardigans, sweaters [, jerseys, raincoats]

International Class(es): 025 - Primary Class

U.S Class(es): 022, 039

Class Status: ACTIVE

Basis: 1(a)

First Use: Sep. 10, 1997

Use in Commerce: Sep. 10, 1997

Basis Information (Case Level)

Filed Use: No

Currently Use: Yes

Amended Use: No

Filed ITU: Yes

Currently ITU: No

Amended ITU: No

Filed 44D: No

Currently 44D: No

Amended 44D: No

Filed 44E: No

Currently 44E: No

Amended 44E: No

Filed 66A: No

Currently 66A: No

Filed No Basis: No

Currently No Basis: No

Current Owner(s) Information

Owner Name: SANTONI SOCIETA' PER AZIONI

Owner Address: VIA MONTE NAPOLEONE 9
MILANO 20121
ITALY

Legal Entity Type: CORPORATION

State or Country Where
Organized: ITALY

Attorney/Correspondence Information

Attorney of Record

Attorney Name: Nicholas D. Wells

Docket Number: 4651.337

Attorney Primary Email nwells@wellsiplaw.com

Attorney Email Authorized: Yes

Address:

Correspondent

Correspondent Name/Address: Nicholas D. Wells
Wells IP Law

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Salt Lake City, UTAH 84111
UNITED STATES

Phone: 8014447143

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Correspondent e-mail: nwells@wellsiplaw.com

Correspondent e-mail Yes

Authorized:

Domestic Representative

Domestic Representative Name: Nicholas D. Wells

Phone: 8014447143

Fax: 2032953730

Domestic Representative e-mail: nwells@wellsiplaw.com

Domestic Representative e-mail Yes
Authorized:

Prosecution History

Date	Description	Proceeding Number
Nov. 12, 2013	ATTORNEY REVOKED AND/OR APPOINTED	
Nov. 12, 2013	TEAS REVOKE/APPOINT ATTORNEY RECEIVED	
Mar. 27, 2013	AUTOMATIC UPDATE OF ASSIGNMENT OF OWNERSHIP	
Jun. 29, 2010	REGISTERED AND RENEWED (FIRST RENEWAL - 10 YRS)	75184
Jun. 29, 2010	REGISTERED - SEC. 8 (10-YR) ACCEPTED/SEC. 9 GRANTED	
May 13, 2010	CASE ASSIGNED TO POST REGISTRATION PARALEGAL	75184
May 12, 2010	TEAS SECTION 8 & 9 RECEIVED	
May 13, 2009	APPLICANT/CORRESPONDENCE CHANGES (NON-RESPONSIVE) ENTERED	88888
May 13, 2009	TEAS CHANGE OF OWNER ADDRESS RECEIVED	
Nov. 29, 2007	TEAS CHANGE OF CORRESPONDENCE RECEIVED	
Mar. 31, 2006	CASE FILE IN TICRS	
Sep. 10, 2005	REGISTERED - SEC. 8 (6-YR) ACCEPTED & SEC. 15 ACK.	
Sep. 06, 2005	ASSIGNED TO PARALEGAL	59807
Aug. 02, 2005	REGISTERED - SEC. 8 (6-YR) & SEC. 15 FILED	
Aug. 02, 2005	PAPER RECEIVED	
Nov. 16, 2000	CERTIFICATE OF CORRECTION ISSUED	
Jun. 22, 2000	SEC 7 REQUEST FILED	
May 16, 2000	REGISTERED-PRINCIPAL REGISTER	
Mar. 16, 2000	ALLOWED PRINCIPAL REGISTER - SOU ACCEPTED	
Mar. 08, 2000	STATEMENT OF USE PROCESSING COMPLETE	
Dec. 22, 1999	USE AMENDMENT FILED	
Jul. 27, 1999	NOA MAILED - SOU REQUIRED FROM APPLICANT	
May 04, 1999	PUBLISHED FOR OPPOSITION	
Apr. 02, 1999	NOTICE OF PUBLICATION	
Jan. 19, 1999	APPROVED FOR PUB - PRINCIPAL REGISTER	
Jan. 19, 1999	ASSIGNED TO EXAMINER	66582
Jan. 13, 1999	ASSIGNED TO EXAMINER	74665

Maintenance Filings or Post Registration Information

Affidavit of Continued Use: Section 8 - Accepted

Affidavit of Incontestability: Section 15 - Accepted

Renewal Date: May 16, 2010

Change in Registration: Yes

Correction made to Registration: In the statement , column 1, line 1, "ANDREA, SANTONI " is deleted, and " SANTONI, ANDREA " is inserted.

TM Staff and Location Information

TM Staff Information - None

File Location

Current Location: Not Found

Date in Location: Jun. 29, 2010

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